

FREE TRANSMITTAL for FY 2003

Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT

(\$) **160.00**

Complete if Known

Application Number

09/939,491

Filing Date

8/24/2001

First Named Inventor

White

Examiner Name

Mcormick

Art Unit

164

Attorney Docket No.

PH

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METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:

Deposit Account Number
Deposit Account Name

50-2485

Mark P. Bourgeois

The Commissioner is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Credit any overpayments
☐ Charge any additional fee(s) during the pendency of this application
☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	740	2001	370	Utility filing fee	
1002	330	2002	165	Design filing fee	
1003	510	2003	255	Plant filing fee	
1004	740	2004	370	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1) (\$) **160.00**

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims		Extra Claims		Fee from below		Fee Paid
Independent	Multiple Dependent	-20** =	-3** =			

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	84	2201	42	Independent claims in excess of 3
1203	280	2203	140	Multiple dependent claim, if not paid
1204	84	2204	42	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$) **160.00**

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for ex parte reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	400	2252	200	Extension for reply within second month	
1253	920	2253	460	Extension for reply within third month	
1254	1,440	2254	720	Extension for reply within fourth month	
1255	1,960	2255	980	Extension for reply within fifth month	
1401	320	2401	160	Notice of Appeal	
1402	320	2402	160	Filing a brief in support of an appeal	160
1403	280	2403	140	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,280	2453	640	Petition to revive - unintentional	
1501	1,280	2501	640	Utility issue fee (or reissue)	
1502	460	2502	230	Design issue fee	
1503	620	2503	310	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	740	2809	370	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	740	2810	370	For each additional invention to be examined (37 CFR 1.129(b))	
1801	740	2801	370	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) **160.00**

SUBMITTED BY

(Complete if applicable)

Name (Print/Type)

Mark P. Bourgeois

Registration No.
(Attorney/Agent)

37,782

Telephone 574-522-7996

Signature

Date

3/29/2003

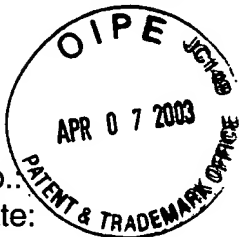
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This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Washington, DC 20231.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In RE:



Serial no.: 09/939,491
Filing date: 08/24/2001
For: Clematis plant named 'Avalanche'
Inventor: White
Atty. Docket no.: PH41
Group Art Unit: 1661
Examiner: McCormick

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Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

Dear Sir:

This is in response to the Notice of Appeal filed February 18, 2003.

Enclosed are triplicate copies of the appeal brief as required.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Mark P. Bourgeois".

Mark P. Bourgeois
Reg. No. 37,782

APPEAL BRIEF

Real Party in interest

The real party in interest in the present appeal brief is Anthony Robin White.

Related Appeals and Interferences

There are no related appeals or interferences.

Status of Claims

Claim 1 is pending. Claim 1 was finally rejected under 35 U.S.C. 102b as being unpatentable over plant breeders rights certificate number 4711 in view of public sales in the United Kingdom. The final rejection of claim 1 is being appealed.

Status of Amendments

There are no amendments that have not been entered.

Summary of Invention

The invention is a Clematis plant named 'Avalanche'. The invention is exemplified in claim 1, which recites a new and distinct variety of Clematis plant named 'Avalanche' as described and illustrated.

Support for this is found in the specification on pages 1-7 and is shown in figures 1-3.

Issues

Issue 1 - Whether claim 1 is patentable under 35 USC 102 in view of plant breeders right publication number 4711 and being on sale in the United Kingdom.

Grouping of Claims

For each ground of rejection, which appellant contests herein, which applies to more than one claim, such additional claims, to the extent separately identified and argued below, do not stand or fall together.

Argument

Issue 1 - Whether claim 1 is patentable under 35 USC 102 over Plant Breeders right publication 4711 in view of sales in the United Kingdom.

Independent claim 1 recites a new and distinct variety of Clematis plant named 'Avalanche' as described and illustrated.

The Examiner has noted that the variety that is the subject of this application has previously been protected by a plant breeder's rights certificate in one or more foreign countries. The Examiner further notes that the referenced plant breeder's rights certificate was published more than one year prior to the filing date of this plant patent application in the United States. The Examiner has used 37 CFR 1.105 to request information from the Applicant regarding whether the variety was publicly available anywhere in the world prior to the filing date of the present application. The Examiner cites *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (BPAI 1992) as authority for this request for information.

The public use and availability of the subject plant variety outside of the United States is not material to a determination of "plant patentability" of a plant variety in the

*

United States under 102b.

The examination strategy set forth by the Examiner results in a denial of plant patent protection in the United States based upon prior art which does not make the plant variety available or accessible to the American public. It is the Applicant's belief that the Federal Circuit will not support any rejection based on such an examination policy.

The Examiner cites *Ex parte Thomson*, 24 USPQ 2d 1618, 1620 (BPAI 1992) to support the contention that a printed publication describing a new asexually reproducible plant variety, combined with the availability of the variety anywhere in the world, is sufficient to bar "plant patentability" of the variety under 35 U.S.C. 102(b).

The *Ex Parte Thomson* board admits that the printed publications cited were not, in and of themselves, enabling, and attempts to make those references enabling by combining them with the public availability of the cotton seeds in Australia. A non-enabling printed publication by itself cannot be cited as prior art under 102(b). Foreign public use alone cannot be cited as prior art under 102(b). *Ex Parte Thomson* combined these two non-prior art references.

It is improper to rely on a combination of references to anticipate the claimed invention under 35 U.S.C. 102(b). *Studiengesellschaft Kohle, M.B.H. v. Dart Industries, Inc.*, 726 F.2d 724, 726 (Fed. Cir. 1984). Anticipation must be found in a single reference. It is proper to cite an additional reference in making a rejection under 35 U.S.C. 102(b) only to show that the claimed subject matter, every material element of which is disclosed in the primary reference, was in possession of the public. See *Application of Samour*, 571 F.2d 559, 565 (CCPA 1978).

Ex Parte Thomson represents an improper use of 102(b) to deny utility patent protection for a plant variety based upon prior art references.

35 U.S.C. 102(b) reads, in pertinent part:

A person shall be entitled to a patent unless
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States . . .


If an invention has been in widespread public use in France for the last 30 years, but is not the subject of any printed publication, then the inventor has every right to file for and obtain patent protection in the United States. Section 102(b) allows such a result. The foreign use of the invention is not deemed to have made the invention available to the American public. It is immaterial to any 102(b) analysis that the French public may have had the invention for the last 30 years.

In order for the American public to access, use and duplicate a plant variety, propagatable plant material from the plant in question must be available in the United States. Without access to the plant material, the plant cannot be reproduced.

Foreign asexually propagatable plant material is not freely accessible to the American public on an unregulated basis. The Plant Quarantine Act of 1912 controls the importation of nursery stock into the United States. The quarantine act imposes rigorous importation requirements.

The court in *In re LeGrice* established a workable and rational approach for applying the policy and the language of 102(b) to this situation. The *In re LeGrice* case was concerned with whether or not foreign plant varieties are actually available to the American public. In the future, a printed publication might enable a person to make a

genetic duplicate or clone, of a particular plant without access to the plant itself. This is not possible at the present time. The *LeGrice* decision disregards public use of a plant variety in a foreign country more than one year prior to the U.S. plant patent filing date as being immaterial to its analysis of the 102(b) rejection based upon printed publications.

Under 35 U.S.C. 102(b), an invention is not patentable if it was described in a printed publication, in this or a foreign country, more than a year prior to the filing date of the U.S. application. In order for a printed publication to serve as a reference under 35 U.S.C. 102(b), it must enable the invention. *In re Donohue*, 766 F.2d 531, 533 (Fed. Cir. 1985). A written description of a plant variety is not enabling. Plant patents have always  been exempt from the Section 112 written enablement requirement, which applies to all utility patents. A particular plant cannot be reproduced by reference only to a printed publication alone. Congress acknowledged this concept when the Plant Patent Act was drafted.

A non-enabling publication fails as a reference under 102(b). Foreign public or commercial activity fails as a barring activity under 102(b). Combining these two “non-references” to make a rejection under 102(b) is not proper.

The narrow scope of protection offered by a plant patent has a direct bearing on the scope of prior art that can be properly considered in determining the patentability of a new plant variety. Because a plant patent cannot be infringed without access to the new plant or its asexual progeny, a new plant variety cannot be anticipated without direct access in the United States to the new plant.

For a plant patent, propagatable material of the new variety is not only essential to enable the invention. It is the invention. In the absence of propagatable material, the

variety does not exist, nor can it be made from the description in any printed publication, regardless of how detailed or specific. Without any publicly available asexually propagatable plant material in the United States, no plant variety can, at the present level of technology, be anticipated by a printed publication, regardless of how detailed it is, and regardless of where it is published. The holding of *In Re LeGrice* is therefore controlling in the present case.

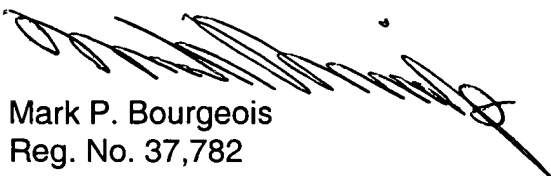
For the foregoing reasons, the cited Plant Breeder's Rights Certificate and sales in the United Kingdom are not a bar to patentability of the claimed new variety under 35 U.S.C. 102(b), because propagatable material of the variety is not available in the United States.

Conclusion

It has long been the practice of the U.S. Patent & Trademark Office to disregard the existence of foreign Plant Breeder's Rights certificates in determining patentability of a new plant variety. The USPTO has previously not considered foreign publication, use, or sale of a new plant variety to be a bar to patentability in the United States.

For the extensive reasons advanced above, Appellant respectfully contends that the claim is patentable. Accordingly, reversal of all rejections is courteously solicited.

Respectfully submitted,



Mark P. Bourgeois
Reg. No. 37,782

Appendix

The claims involved in the appeal follow below:

1. A new and distinct variety of Clematis plant named 'Avalanche' as described and illustrated.



PTO/SB92 (08-00)

Approved for use through 10/31/2002. OMB 0651-0031

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**Assistant Commissioner for Patents
Washington, D.C. 20231**

on April 1, 2003
Date


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Mark K Bougeois
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